

REMARKS

This is a full and timely response to the non-final Office Action mailed October 20, 2005. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

Present Status of Patent Application

Upon entry of the amendments in this response, claims 1-9, 11, 13-21, and 23-25 remain pending in the present application. More specifically, claims 3-9, 14-21 remain withdrawn from consideration; claim 2 is an unamended original claim; claims 1, 11 and 13 are currently amended with no introduction of new matter; claims 23-25 have been newly submitted with no new material being added; and claims 10, 12, and 22 are canceled.

Applicants reserve the right to pursue the subject matter of the canceled claims in a continuing application, if Applicants so choose, and do not intend to dedicate canceled subject matter to the public. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

A. Rejections under 35 U.S.C. §103(a)

Statement of the rejection

- 1) Claims 1, 13, (and 2) are rejected under 35 U.S.C. 103(a) as being unpatentable over Pankratov et al. (4,865,029) in view of Tymianski et al. (6,571,482).
- 2) Claims 10, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pankratov et al. (4,865,029) in view of Tymianski et al. (6,571,482) and further in view of Wang et al. (2002/0122638).
- 3) Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pankratov et al. (4,865,029) in view of Tymianski et al. (6,571,482) and Wang et al. (2002/0122638) and further in view of Hamm (6,263,133).

Response to the rejection

Attention is respectfully drawn to MPEP 706.2(j) *Contents of a 35 U.S.C. 103*

Rejection, which states in pertinent part:

To establish a *prima facie* case of obviousness, **three basic criteria must be met**. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of

success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria. (Emphasis added)

Responsive remarks related to individual claims are provided below using the criteria described in MPEP 706.2(j).

Claim 1

The first of the three basic criteria that must be met to establish a *prima facie* case of obviousness relates to some suggestion or motivation being present to modify the reference or to combine reference teachings. The Office Action admits that "Pankratov et al does not disclose the GRIN element arranged with the first end surface adjacent the light emitting device." However, the Office Action follows this admission with the assertion that "it would have been obvious to one of ordinary skill the art to form the Pankratov et al.'s device having the GRIN element arranged with the first end surface adjacent the light emitting device such as taught by Tymianski et al. *in order to maximize the focused light beams.*" (Emphasis added)

Applicants respectfully traverse this assertion because Pankratov does not suggest "maximizing the focused light beams." To the contrary, **Pankratov teaches away** from such maximization. In this regard, Applicants respectfully draw attention to Pankratov col. 3, lines 32-37, reproduced below for easy reference:

Ideally, a surgeon using such a probe is to estimate the diameter of region T and the fiber-to-tissue distance accurately, because the inverse square intensity relationship can result in undesired perforations, scarring or deep tissue damage if the probe is brought too close to the layer of tissue to be treated. (Emphasis added)

In addition to the cited text above, Pankratov, in his "Technical Field" section, highlights the dangers of using high power light energy in surgical applications. He further suggests in his (col. 2, lines 2-4), the desirability of his invention which is designed "so as to achieve plural different spot sizes, each having a known power density." Towards this end, Pankratov's (col. 3, line 65 to col. 4, line 2) further describes his invention as follows:

In the schematic representation of FIG. 2, holder 6 is a tubular member having lens 4 centrally mounted therein. Holder 6 is coaxial with fiber 50, and is adapted for motion along the axis of the fiber so as to position lens 4 a variable distance from end face 52 thereof.

Pankratov's lens is adapted for motion so as to achieve different spot sizes, rather than fixed at one optimal location, such as adjacent the light emitting device, for achieving maximum light intensity. Consequently, Applicants respectfully assert that one of ordinary skill in the art

would not have been motivated “to form the Pankratov et al.’s device having the GRIN element arranged with the first end surface adjacent the light emitting device such as taught by Tymianski et al. *in order to maximize the focused light beams*,” as stated in the Office Action.

Due to the reasons described above, Applicants respectfully assert that the rejection of Claim 1 fails to satisfy the first of the three MPEP criteria for establishing a *prima facie* case of obviousness as necessary for a proper rejection under 35 U.S.C. 103(a).

Applicants further assert that currently amended Claim 1 contains certain elements that are not taught or disclosed in the cited prior art. Consequently, it would be improper to use the presently cited prior art to reject Claim 1 under 35 U.S.C. 103(a) because such a rejection would fail to satisfy the third of the three criteria, vis-à-vis “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” This assertion is justified below in further detail.

Currently amended Claim 1 includes “a header” element, which the Office Action admits in page 4, para 2, is not anticipated by the cited prior art: “Tymianski et al. and Pankratov et al. do not disclose the light emitting device additionally comprises a header, the header comprises a cavity extending thereinto...” The header of Applicants’ Claim 1 is further defined as “having a second diameter slightly smaller than the first diameter,” where the first diameter refers to a cylindrical body of Applicants’ GRIN element. This aspect is not disclosed in the cited prior art.

Furthermore, Applicants’ currently amended Claim 1 also includes “a push fit hermetic seal” element that is not disclosed in the cited prior art. The push fit aspect had been defined earlier in Applicants’ rejected Claim 10, which has been currently canceled. In rejecting Claim 10, the Office Action points out that only the final product is relevant, not the process of making such a product and that a “product by process” claim is directed to the product per se, no matter how actually made. In amending Claim 1 to include the push fit aspect, Applicants’ have taken care to define the nature of the hermetic seal as a “push fit hermetic seal.” Applicants respectfully assert that the push fit hermetic seal is a “product,” which is independent of the “process” used in making it. Such a “product” is not disclosed in Pankratov and hence it would be improper to use this cited prior art for rejecting amended Claim 1 under 35 U.S.C. 103(a).

In summary, for at least the reasons described above, Applicants respectfully request withdrawal of the rejection of Claim 1 under 35 U.S.C. 103(a), followed by allowance of Claim 1.

Claim 13

Responsive remarks related to the rejection of system Claim 1 are equally applicable to

the rejection of Claim 13, which defines a method of making a light emitting device. Therefore, in the interests of brevity, these remarks will not be repeated herein.

Applicants respectfully requests withdrawal of the rejection followed by allowance of Claim 13.

Claim 2

Because currently amended independent claim 1 is allowable, claim 2 that depends directly on claim 1 is also allowable as a matter of law. *In re Fine*, 837 F. 2d 1071 (Fed. Cir. 1988).

Consequently, Applicant requests withdrawal of the rejection followed by allowance of Claim 2.

Claims 10 and 22

Claims 10 and 22 have been currently canceled thereby rendering moot the rejection of these claims.

Claim 11

Because currently amended independent claim 1 is allowable, claim 11 that depends directly on claim 1 is also allowable as a matter of law. *In re Fine*, 837 F. 2d 1071 (Fed. Cir. 1988).

Consequently, Applicant requests withdrawal of the rejection followed by allowance of Claim 11.

Prior Art Made of Record

The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that at least claims 1, 2, 11, 13, and 23-25 of pending claims 1-9, 11, 13-21, and 23-25 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned representative at (404) 610-5689.

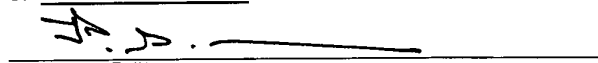
Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA, 22313-1450, on **16 December 2005**



Signature
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